UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,864	12/05/2003	Todd D. Wakefield	03760.020/5137 P	8495

7590	06/13/2006	

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EXAMINER
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ART UNIT	PAPER NUMBER
2163	

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/729,864	WAKEFIELD, ET AL.
	Examiner	Art Unit
	Angela M. Lie	2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>05 December 2003</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-29</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-29</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>05 December 2003</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some *   c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/8/04, 1/7/05</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Double Patenting

1.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

2.   A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

3.   Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4.   Claims 1-10, 16, 24 and 25 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-11, 18, 22 and 27 of copending Application No. 10/729,889. This is a **provisional** double patenting rejection since the conflicting claims have not yet been patented.

5.   Claims 1-10 and 12-29 are provisionally rejected on the ground of nonstatutory double patenting over claims 1- 28 of copending Application No.

10/729,888. This is a **provisional** double patenting rejection since the conflicting claims have not yet been patented.

6.   Claims 1-11 and 16-25 are provisionally rejected on the ground of nonstatutory double patenting over claims 1- 11 and 34-43, of copending Application No. 10/729,883. This is a **provisional** double patenting rejection since the conflicting claims have not yet been patented.

7.   Claim 1 is provisionally rejected on the ground of nonstatutory double patenting over claim 1, of copending Application No. 10/729,833. This is a **provisional** double patenting rejection since the conflicting claims have not yet been patented.

8.   Claims 1-11,13, 16- 25 and 27 are provisionally rejected on the ground of nonstatutory double patenting over claims 1- 12 and 14 - 24, of copending Application No. 10/729,417. This is a **provisional** double patenting rejection since the conflicting claims have not yet been patented.

9.   Claims 1-11,13 and 16- 29 are provisionally rejected on the ground of nonstatutory double patenting over claims 1- 11, 13, and 27-38 of copending Application No. 10/729,414. This is a **provisional** double patenting rejection since the conflicting claims have not yet been patented.

10.   Claims 1-13 and 16-27 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-13 and 28-39 of copending Application No. 10/729,388. This is a **provisional** double patenting rejection since the conflicting claims have not yet been patented.

11.   Claims 1-13 and 16-27 are provisionally rejected on the ground of

nonstatutory double patenting over claims 1-13 and 28-39 of copending

Application No. 10/729,388. This is a **provisional** double patenting rejection

since the conflicting claims have not yet been patented.

12.   Claims 1-11 and 16-25 are provisionally rejected on the ground of

nonstatutory double patenting over claims 1-11 and 33-42 of copending

Application No. 10/728,721. This is a **provisional** double patenting rejection

since the conflicting claims have not yet been patented.

13.   The subject matter claimed in the instant application is fully disclosed in

the referenced copending application and would be covered by any patent

granted on that copending application since the referenced copending application

and the instant application are claiming common subject matter.

Claim Rejections - 35 USC § 101

14.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requirements of this title.

15.   With respect to claims 1 and 16, those claims recite "integrating the

produced data with the data tuples of the structured data", but fails to recite a

tangible result, a requirement for compliance with the provisions of 35 U.S.C. 101

in view of Interim Guidelines for Examination of Patent Applications for Patent

Subject Matter Eligibility, published on October 26, 2005, which can be found at

**http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101
_20051026.pdf**, particularly with respect to ANNEX IV Computer-Related

Nonstatutory Subject Matter, beginning on page 50.

16.   In order to obtain a tangible result, the applicant ought to clearly disclose

of how this integration process takes place. Furthermore, it is also unclear from

the disclosure language of claims 1 and 16, what is the final result of the

integration, in other words, in what manner the structured and produced data are

combined.

17.   Claims 1-14 and 16-28 are rejected under 35 U.S.C. 101 because the

claimed invention lacks patentable utility. The integrated data as disclosed in

claims 1 and 16, has no use unless it can be displayed to a user in a human

readable format. In order to overcome this rejection, the applicant needs to add a

limitation teaching displaying of the result, for instance such a limitation is

disclosed in claims 15 and 29.

18.   Furthermore, claims 2-15 refer to the computer program in the preamble,

which in fact is a non-statutory subject matter, instead the applicant is advised to

use the phrase a computer program located in the computer human readable

medium.

Claim Objections

19.   Claims 1 and 16 are objected to because of the following informalities:

The phrase "wherein is contained information" is grammatically incorrect.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

20.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

21.   Claims 1 and 16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

22.   Claims 1 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step is: matching the produced data with the corresponding structured data prior to integration step.

Claim Rejections - 35 USC § 102

23.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

24.   The changes made to 35 U.S.C. 102(e) by the American Inventors

Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology

Technical Amendments Act of 2002 do not apply when the reference is a U.S.

patent resulting directly or indirectly from an international application filed before

November 29, 2000. Therefore, the prior art date of the reference is determined

under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C.

102(e)).

25.   <u>Claims 1-13, 15-27 and 29 are rejected under 35 U.S.C. 102(e) as being</u>

<u>anticipated by Poibeau et al (US Publication 20040073874).</u>

As to claims 1 and 16, Poibeau discloses a computer program stored on

the media device and a method of integrating free text comprising functions and

steps of: accessing a database of structured data (paragraph 58), the structured

data comprising a set of data tuples (as shown in Figure 4 below, structured

data) wherein an information is contained, according to a coded data format;

accessing a source of free text (as indicated in figure 4 below), the free text being

relatable to the data tuples of the structured data (as shown in figure 4 below, i.e.

product of integration); interpreting the free text to produce a set of construed

data reflecting at least one relational fact conveyed in the free text, each

construed datum relatable to a data tuple of the structured data (as shown in

figure 4 below, i.e. TAG_TEXT); and integrating the produced data with the data

tuples of the structured data, the integrating producing integrated data (Figure 4,
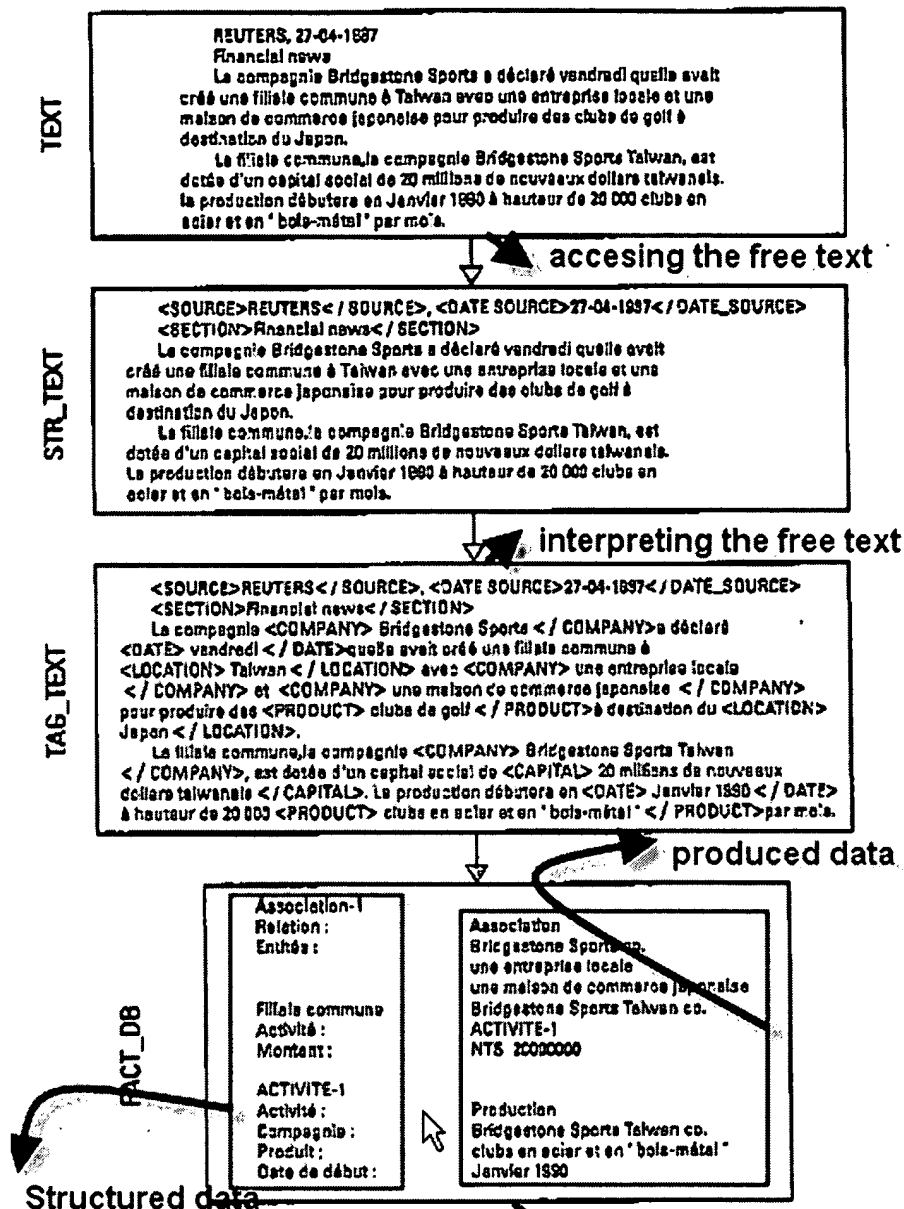
FACT_DB).

Fig. 4 ◢Product of integration

As to claims 2 and 17, Poibeau discloses a computer program located on

a computer human readable medium wherein the accessing a source of free text

access text contained within the database of structured data (paragraphs 66, 67,

68 and 69, depending on the text only certain structured tag data is extracted,

paragraph 23, lines 9 and 10).

As to claims 3 and 18, Poibeau discloses a computer program located on a computer human readable medium wherein the accessing a source of free text and the accessing a database of structured data access two separate data sources (paragraph 23, "defined data structure", since the free text is provided on a disk or via internet and the structured data is predefined, it has to be supplied separately from the free text document, i.e. independently of the supplied document, the same tags (structured data) will apply).

As to claims 4 and 19, Poibeau discloses a computer program located on a computer human readable medium wherein the instructions are further executable to perform the function of applying caseframes while performing the interpreting of the free text (paragraphs 28 and 37).

As to claims 5 and 20, Poibeau discloses a computer program located on a computer human readable medium wherein the instructions are further executable to perform the function of producing a new database (paragraph 23, wherein forming separate file is equivalent with forming a database) containing the integrated data produced by the integrating.

As to claims 6 and 21, Poibeau discloses a computer program located on a computer human readable medium wherein the instructions are further executable to perform the function of inserting the produced data into the database of structured data while performing the integrating the produced data (paragraph 57).

As to claims 7 and 22, Poibeau discloses a computer program located on a computer human readable medium wherein the instructions are further

executable to perform the function of creating a new database while performing

the integrating the produced data (paragraph 23).

As to claims 8 and 23, Poibeau discloses a computer program located on

a computer human readable medium wherein the instructions are further

executable to produce a new relational database containing the integrated data

produced by the integrating (paragraph 23).

As to claims 9 and 24, Poibeau discloses a computer program located on

a computer human readable medium wherein the instructions are further

executable to produce a file containing the integrated data produced by the

integrating (paragraph 23, wherein the database is interpreted as file).

As to claims 10 and 25, Poibeau discloses a computer program located on

a computer human readable medium wherein the instructions are further

executable to produce a file having a format selected from the group of XML,

character separated values, spreadsheet formats and file-based database

structures (paragraph 22).

As to claim 11, Poibeau discloses a computer program located on a

computer human readable medium comprising: a processing unit coupled to the

one or more storage media devices, the processing unit being capable of

executing the instructions (paragraph 22, lines 1-2); and an execution command

unit, whereby operation of the instructions and the processing unit may be

commanded or controlled (the software for processing free text provides the set

of instructions performed by the processing unit).

As to claims 12 and 26, Poibeau discloses a computer program located on a computer human readable medium wherein the instructions are further executable to store an integrated database while performing the integrating the produced data (paragraph 23).

As to claims 13 and 27, Poibeau discloses a computer program located on a computer human readable medium wherein the integrated data produced by the performance of the integrating the produced data includes reference information to the original free text for construed data (Figure 4 above, TAG_TEXT). `

As to claims 15 and 29, Poibeau discloses a computer program located on a computer human readable medium wherein the instructions are further executable to render a visual representation all or a part of the integrated data (paragraph 22, lines 1-3, since the computer has a monitor and memory on which the integrated data is stored, the apparatus has a capacity to display the data).

Claim Rejections - 35 USC § 103

26.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

27.   Claims 14 and 28 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Poibeau et al (US Publication 20040073874) in the view of

Smith et al (US Publication 20030061212). Poibeau teaches all the limitations

presented in claims 1 and 16, respectively, however his disclosure lacks the

teaching about data mining on the integrated data. Smith teaches a method for

analyzing data, comprising the step data mining of the extracted portion of the

data (paragraph 22). It would have been obvious to one of the ordinary skill in the

art during the time the invention was made to use data mining as taught by Smith

on the integrated data as taught by Poibeau because data mining of the obtained

relevant information can allow for pattern monitoring (Smith, paragraph 19) which

in fact can simplify analyzing collected data.

The Prior Art

28.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

-        US Patent 6292771 discloses a method for language processing

         and encoding of a free text into a medical database.

-        US Patent 5715468 discloses storing and retrieving data in natural
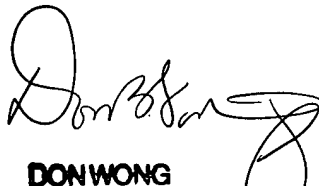
         (free text) language.

Inquiry

29.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela M. Lie whose telephone number is 571-272-8445. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Angela M Lie

DON WONG
SUPERVISORY PATENT EXAMINER